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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,453	03/17/2000	MASAAKI HORI	105637	3066

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EXAMINER

BURLESON, MICHAEL L

ART UNIT PAPER NUMBER

2626

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/527,453

Applicant(s)

HORI, MASAOKI

Examiner

Michael Burleson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
- 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
- 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

2. The information disclosure statement (IDS) was submitted on March 17, 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tokunori Kato US 2002/0048040.

5. Regarding claims 1-6, Kato teaches of a communication apparatus (page 1, paragraph 0025, lines 1-2), that attaches scanned data from a facsimile apparatus to an e-mail (page 3, paragraph 0038, lines 3-5), for use with a telephone exchange that is connected to the internet (page 2, paragraph 0026, lines 8-10), which reads on an information network. The communication apparatus includes a personal computer, which includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a position and recipient inputting device and a writing device. The CPU of the communication apparatus transmits the facsimile data by attaching it to an e-mail (page 3, paragraph 0038, lines 2-5 and paragraph 0040, lines 1-7), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device and the position information input by the position information device.

6. The operator can select a receiver's name, which reads on a piece of a recipient's information for one piece of the e-mail and mail address, which reads on position information according to pieces of the recipient's information inputted (page 3, paragraph 0040, lines 4-7). The facsimile apparatus of the communication apparatus that scans a document and attaches the scanned data to an e-mail (page 3, column 0038, lines 3-6), which reads on a reading device that reads from an original document, the facsimile data to be attached to an e-mail and then transmitted. The facsimile

apparatus also transmits and receives facsimile data by a public line (page 2, paragraph 0026, lines 14-16).

7. Regarding claim 7, Kato teaches that the CPU contains an address list managing program that comprises of mail address boxes (page 3, paragraph 0040, lines 2-6), which reads on the broadcast to a plurality of recipients and disclosure information, which also includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a device for inputting disclosure information.

8. Regarding claims 8-10, the communication apparatus includes a personal computer, which includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a writing device that writes information into a body of the e-mail before transmission. The facsimile apparatus of the communication apparatus that scans a document and attaches the scanned data to an e-mail (page 3, column 0038, lines 3-6), which reads on a reading device that reads from an original document, the facsimile data to be attached to an e-mail and then transmitted. The facsimile apparatus also transmits and receives facsimile data by a public line (page 2, paragraph 0026, lines 14-16), which reads on a facsimile data transmission/reception device that only transmits/receives the facsimile data by a public line.

9. Regarding claims 11, Kato teaches a communication apparatus (page 1, paragraph 0025, lines 1-2), that attaches scanned data from a facsimile apparatus to an e-mail (page 3, paragraph 0038, lines 3-5), for use with a telephone exchange that is connected to the internet (page 2, paragraph 0026, lines 8-10), which reads on an information network. The CPU contains an address list-managing program that

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comprises of mail address boxes (page 3, paragraph 0040, lines 2-6), which reads on the broadcast to a plurality of recipients. The communication apparatus includes a personal computer, which includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a position, recipient inputting device and a device for inputting disclosure information. The CPU of the communication apparatus transmits the facsimile data by attaching it to an e-mail (page 3, paragraph 0038, lines 2-5 and paragraph 0040, lines 1-7), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device and the position information input by the position information device.

10. Regarding claims 12-14, Kato teaches that the communication apparatus includes a personal computer, which includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a writing device that writes information into a body of the e-mail before transmission. The facsimile apparatus also transmits and receives facsimile data by a public line (page 2, paragraph 0026, lines 14-16), which reads on a facsimile data transmission/reception device that only transmits/receives the facsimile data by a public line. The communication apparatus includes a personal computer, which includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a position and a device for inputting disclosure information are a common device.

11. Regarding claims 15-16, Kato also teaches of a storage medium for storing computer programs (page 3, paragraph 0040, lines 2-6 and page 4, paragraph 0055,

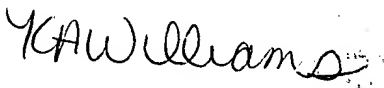
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lines 6-21), which reads on a storage medium for storing a program for controlling a communication apparatus that transmits facsimile data by attaching the facsimile data to an email and broadcasts to a plurality of recipients facsimile data by attaching it to an email, recipient information inputting program, position information program, disclosure information inputting program and transmission program.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bloomfield US 6,025,931 and Witek US 5,461,488.

13. Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (703) 305-8683 and fax number is (703) 746-3006. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at (703) 305-4863


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER

Michael Burleson
Patent Examiner
Art Unit 2626

Mlb
January 17, 2004